

Docket No.: SYM-606C

REMARKS

In an office action dated 20 May 2005, the Examiner rejects claims 52, 54-56, 58-60, 62-64, 66 and 67. In response to the office action, Applicants respectfully traverse the rejections. Claims 52, 54-56, 58-60, 62-64, 66, and 67 remain pending in this application. In light of the below arguments, Applicants respectfully request that the Examiner allow all pending claims and allow this application.

Applicants would like to voice the Applicants displeasure with the introduction of a new rejection in to the claims in this Application. Applicants relied upon the Examiner's assertion that certain claims were allowable when amending the claims which changes the scope of the claims. Had Applicants known another rejection, Applicants may have chosen another avenue to pursue. Applicants feel doped into limiting the claims for the purpose of allowing the application only to have the Examiner continue prosecution. The Examiner is reminded the Examiner is not to "make a new search in the mere hope of finding something." See MPEP § 706.04.

In the office action, the Examiner rejects claim 52 under 35 U.S.C. §103(a) as being unpatentable over "Requests for Comments 2131: Dynamic Host Configuration Protocol" (RFC) in view of U.S. Patent Number 5, 692, 197 issued to Narad et al. (Narad). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed

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element. Id. The Examiner has failed to provide a teaching of each and every claimed element and has failed to provide a proper motivation to combine the references.

Claim 52 recites setting a time to a time prior to the termination time and setting the mobile terminal to a sleep state responsive to setting a timer. Neither RFC nor Narad teaches these limitations. RFC does not teach setting a timer. Instead, RFC merely teaches "the client maintains two times, T1 and T2." See 4.4.5, page 40. There is no mention that this must be done by setting a timer. There are many other methods by which a time may be maintained such as time stamps. Thus, maintaining two times does not teach setting a timer.

Narad also does not teach setting a timer to a time prior to the termination time. Instead, Narad merely teaches that a computer system may be set to an active state in response to a deterministic event such as the elapsing of a timer. See col.2, lines 54-67. However, there is no where in the entirety of the Narad reference that teaches the setting of a timer for a purpose. More specifically, there is no teaching anywhere in Narad of setting a timer to a time prior to the termination time as recited in claim 52. The section of Narad cited by the Examiner teaches waking up in response to a timer but does not in any way teach setting a timer.

Since neither RFC nor Narad teach setting a timer, the combination of the references does not teach setting a timer. Thus, Applicants respectfully request that the rejection of claim 52 be removed and claim 52 be allowed.

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Furthermore, even if the combination of references teach setting a timer the Examiner has not provided a proper combination or a motivation to combine the references. The Examiner states that Narad teaches a system for making a computer appear active on a network while conserving energy. There is no discussion of conserving energy in RFC or even a statement of a potential problem in RFC of a computer being in a sleep state. In Fact RFC gives a viable solution to this problem in that a computer that does not extend a lease of an IP address may be placed in an INIT mode to receive a new address. Thus, the Examiner is addressing a problem that is solved in the RFC.

Furthermore, Examiner is reminded that a combination is improper if the combination changes the intended purpose of a reference. Narad is directed to a system for making a computer system appear continuously active. See Col. 3, lines 1-6. However, the proposed combination only wakes the computer system up to send a lease extension request and does not make the system appear continuously active. Thus, the combination is improper. Thus, Applicants respectfully request that the rejection of claim 52 be removed and claim 52 be allowed.

Claims 54-55 are dependent upon claim 52. Thus, claims 54-55 are allowable for at least the same reasons as claim 52. Therefore, Applicants respectfully request that claims 54-55 be allowed.

Claims 58-59 are dependent upon claim 56. Thus, claims 58-59 are allowable for at least the same reasons as claim 56. Therefore, Applicants respectfully request that claims 58-59 be allowed.

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Claims 62-63 are dependent upon claim 60. Thus, claims 62-63 are allowable for at least the same reasons as claim 60. Therefore, Applicants respectfully request that claims 62-63 be allowed.

Claims 66-67 are dependent upon claim 65. Thus, claims 66-67 are allowable for at least the same reasons as claim 65. Therefore, Applicants respectfully request that claims 66-67 be allowed.

If the Examiner has a question about this response or the application in general, the Examiner is invited to telephone the Applicants at 775-586-9500.

Respectfully submitted,
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